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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/893,296   | 06/27/2001  | Andre Morkel         | PEST-P01-002        | 1997             |
| 28120  | 7590        | 12/17/2004           | EXAMINER            |                  |
| ROPES & GRAY LLP<br>ONE INTERNATIONAL PLACE<br>BOSTON, MA 02110-2624 |             |                      | DALENCOURT, YVES    |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |

2157

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/893,296

Applicant(s)

MORKEL, ANDRE

Examiner

Yves Dalencourt

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15-20 is/are rejected.
- 7) ☒ Claim(s) 13 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/27/01.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This office action is responsive to communication filed on 06/27/01.

#### ***Specification***

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Therefore, " is disclosed " (line 1 in the abstract) is implied; and should be avoided.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3 – 6, 12, and 15 - 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Druckenmiller et al (US 6,167,435; hereinafter Druckenmiller).

Regarding claim 1, 15 – 17, and 20, Druckenmiller teaches a method and system for secure management of contact information via a network (fig. 1), which comprises the steps of attaching contact information to an e-mail having a recipient's e-mail address (col. 2, lines 62 – 65), associating a transaction ID with the contact information (col. 2, lines 6 – 8; col. 3, lines 22 – 24), associating a first hash of the recipient's e-mail address with the transaction ID (col. 4, lines 58 – 64), transmitting the e-mail with the transaction ID to the recipient via the network (col. 4, lines 64 – 67), producing a second hash of the recipient's e-mail address (col. 5, lines 1 – 3), and if the second hash of the recipient's e-mail address and transmitted transaction ID match the first hash of the recipient's e-mail address and the transaction ID, forwarding the contact information to the recipient (col. 5, lines 33 – 67).

Regarding claim 3, Druckenmiller teaches a method for secure management of contact information via a network (fig. 1), wherein a presence of the contact information is identified in the e-mail by a message appended to the e-mail (col. 3, lines 39 - 42).

Regarding claim 4, Druckenmiller teaches a method for secure management of contact information via a network (fig. 1), wherein a presence of the contact information is identified in the e-mail by a field checked in an e-mail window (24, fig. 2; paragraph bridging col. 2, line 66 through col. 3, line 10).

Regarding claim 5, Druckenmiller teaches a method for secure management of contact information via a network (fig. 1), wherein the contact information is directed to a specified recipient (col. 2, lines 62 - 65).

Regarding claim 6, Druckenmiller teaches a method for secure management of contact information via a network (fig. 1), wherein the contact information is directed to a plurality of recipients listed on a recipient list (col. 2, lines 36 - 42).

Regarding claim 12, Druckenmiller teaches a method for secure management of contact information via a network (fig. 1), which further includes the step of associating security settings with the contact information, with the security settings determining the forwarded contact information displayed at the recipient (col. 4, lines 58 - 67).

Regarding claim 18, Druckenmiller teaches a method for secure management of contact information via a network (fig. 1), wherein the identifier and the recipient's e-mail address define the contact information retrieved from the server (col. 3, lines 54 - 60).

Regarding claim 19, Druckenmiller teaches a method for secure management of contact information via a network (fig. 1), wherein the server stores an association between the contact information and a recipient's e-mail address based on an encrypted value of the recipient's e-mail address (col. 4, lines 58 - 67; col. 5, lines 55 - 67; Druckenmiller discloses that tokens may also be generated by means of a predetermined algorithm which processes the subscriber e-mail address 32 to generate a coded token).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 9 - 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller et al (US 6,167,435; hereinafter Druckenmiller) in view of Creswell et al (US 6,564,264; hereinafter Creswell).

Regarding claims 2 and 9 - 11, Druckenmiller teaches all the limitations in claim 1, but fails to specifically teach the method, wherein attaching the contact information includes checking if the recipient already has a most recent copy of the contact information (claim 2); and wherein the recipient scans a received e-mail for an indication of the presence of updated contact information (claim 9).

However, Crewswell teaches, in the same field of endeavor, a system, apparatus, and method for automatic address updating of outgoing and incoming user messages in a communications network, which comprises the method step, wherein attaching the contact information includes checking if the recipient already has a most recent copy of the contact information (fig. 3, paragraph bridging col. 2, line 62 through col. 3, line 2; col. 4, line 24 through col. 5, line 29; Creswell discloses a test to determine if the contact information of the sender is in the user's data set); and wherein the recipient scans a received e-mail for an indication of the presence of updated contact information col. 2, lines 36 - 48).

Thus, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Druckenmiller's device by determining if the sender address is already in the user's data set as evidenced by Creswell because Creswell suggests updating a contact information by attaching contact information to an e-mail having a recipient's e-mail address, and Creswell further teaches the step of checking whether such updated information is already in the user's data set by performing a scanning process of the incoming message for the for the purpose of relieving the burden of on the user and improving the user's communication efficiency.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druckenmiller et al (US 6,167,435; hereinafter Druckenmiller) in view of Robert H. Reilly; hereinafter Reilly).

Regarding claims 7 and 8, Druckenmiller teaches all the limitations in claim 1, but fails to specifically teach a method, which further includes retaining a history of the forwarded contact information (claim 7); and wherein the history of the contact information is associated with the transaction ID (claim 8).

However, Reilly teaches, in the same filed of endeavor, a systems and methods for automatically forwarding electronic mail when the recipient is otherwise unknown, which includes the steps of retaining a history of the forwarded contact information (paragraph bridging col. 2, lines 63 through col. 3, line 8; col. 3, lines 13 – 26; Reilly discloses that some or all participants in the electronic mail process are aware that there is an entity, the "forwarding listserver", which may be on file and available to an electronic participant); and wherein the history of the contact information is associated

with the transaction ID (col. 3, lines 27 – 31; Reilly discloses that the “forwarding listserver includes the forwarding information such as old electronic mail name and new electronic mail name).

Thus, it would have been obvious to one of ordinary skilled in the art at the time the invention was made to modify Druckenmiller’s device by retaining a history of the forwarded contact information and associated such history with the transaction ID as evidenced by Reilly for the purpose of allowing a one-to-many distribution of electronic mail messages through the operation of the list server.

***Allowable Subject Matter***

Claims 13 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: As specifically claimed, the art of record fail to teach, a method for secure management of contact information via a network (fig. 1), wherein when a recipient on the recipient list receives updated contact information, said updated contact information is automatically sent to the remaining recipients on the recipient list (claim 13).

Also, the art of record fail to teach, a method for secure management of contact information via a network, wherein the recipient has additional e-mail addresses that are linked to the recipient's e-mail address, and the updated contact information is forwarded to the linked e-mail addresses using the same transaction ID (claim 14).



### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Uri Levine (US Patent Number 6,792,082) discloses a voice mail system with personal assistant provisioning.

Jakob Nielsen (US Patent Number 6,405,243) discloses a method and system for updating email addresses.

Nestoriak, III et al (US Patent Number 6,353,852) discloses enhanced telephone service system with secure system and method for e-mail address registration.

### **Contac Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6: 00PM.

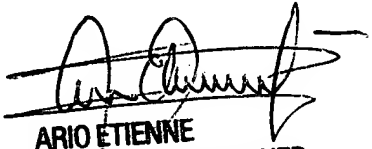
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yves Dalencourt

*Y.D.*  
December 09, 2004

  
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